

an intermediate portion coupling the forefoot portion and the rearfoot portion and constructed of a material and configured to allow, in a pre-selected manner, rotation of the forefoot portion relative to the rearfoot portion about the longitudinal axis.

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#### REMARKS

Applicant hereby amends claims 1, 15, and 21. No new matter has been entered thereby. Claims 1 and 21 are being amended to more clearly define the subject matter of Applicant's invention. Claim 15 is being amended to correct an antecedent basis issue regarding the term "width." The claim amendments are fully supported at, for example, FIG. 1 and page 6, lines 12-20. The Office Action did not address claim 23. Applicant respectfully requests clarification as to whether claim 23, which depends from independent claim 21, is allowable. Claims 1-25 are currently pending.

1. Claim 15 is rejected under 35 U.S.C. 112, second paragraph for failing to provide antecedent basis for the phrase "the width." Claim 15 is hereby amended by replacing "the" with --a-- before "width" in line 1. Applicant submits that the language of claim 15 is now proper. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 15.

2. Claims 1, 9-10, and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,550,597 to Coplans ("Coplans"). Applicant respectfully traverses this rejection as applied to the claims, as amended.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 613 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). See also, MPEP § 2131.

Coplans describes a torsion element 15 having "a front lifting section 16, a rear lifting section 17, and an intermediate twisted section 18." Col. 3, lines 37-40. See also col. 3, lines 46-52 and lines 63-64. As shown in FIGS. 5, 7, 8, and 15, the front lifting section 16 is relatively small and covers less than half of the forefoot area.

In contrast to Coplans, Applicant's claimed invention, as claimed in independent claim 1, comprises a forefoot portion spanning substantially an entire forefoot area of the sole, an intermediate portion, and a rearfoot portion spanning substantially an entire rearfoot area of the sole." Coplans fails to teach a torsion element having a forefoot portion spanning substantially an entire forefoot area of the sole. As such, Applicant respectfully submits that Coplans does not anticipate Applicant's invention as claimed in claim 1 and claims 9-10 and 15, which depend directly or indirectly from independent claim 1.

Reconsideration and withdrawal of the rejection of claims 1, 9-10, and 15 based on Coplans are respectfully requested.

3. Claims 1, 5-11, 15-17, 19-21, and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,922,631 to Anderie ("Anderie").

Anderie shows a shoe bottom for sports shoes that includes a stiffening element 109. The stiffening element 109 includes "forefoot" and "rearfoot" portions (anchoring inserts) 111, 112 and 119, 118. See FIGS. 4 and 6 and col. 5, lines 9-52 of Anderie. As shown in FIGS. 1, 9, and 11, the forefoot and rearfoot portions 111, 112 and 119, 118 are relatively small and do not fully extend into the forefoot and rearfoot areas of the sole, respectfully.

In contrast to Anderie, Applicant's invention relates to a torsion element comprising a forefoot portion spanning substantially an entire forefoot area of the sole, a rearfoot portion spanning substantially an entire rearfoot area of the sole, and an intermediate portion as claimed in amended independent claims 1 and 21. Claims 5-11, 15-17, 19-20, and 24 depend from claims 1 and 21 respectively. The amended claims are supported at, for example, FIGS. 1, 2A1-2A3, 3, and 4.

Anderie fails to disclose a torsion element with forefoot and rearfoot portions that span substantially an entire forefoot area and an entire rearfoot area of the sole. As such, Applicant respectfully submits that Anderie does not anticipate Applicant's invention as claimed in claims 1 and 21 and claims 5-11, 15-17, 19-20, and 24, which depend directly or indirectly from independent claims 1 and 21.

Reconsideration and withdrawal of the rejection of claims 1, 5-11, 15-17, 19-21, and 24 based on Anderie are respectfully requested.

4. Claims 22 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of U.S. Patent No. 5,446,977 to Nagano et al. ("Nagano").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)(emphasis added). MPEP § 706.02(j).

As discussed above, Anderie discloses a shoe bottom for a sports shoe that includes a stiffening element. The stiffening element 109 includes "forefoot" and "rearfoot" portions (anchoring inserts) 111, 112 and 119, 118. The forefoot and rearfoot portions are relatively small and do not span substantially an entire forefoot area and an entire rearfoot area of the sole.

Briefly, Nagano discloses a cycling shoe having a removable portion. The cycling shoe includes a peripheral portion 2 and a sole 3. The sole includes a bottom sole 4, a middle sole 6 for attaching a cleat 5, and an insole 7. See col. 3, line 63 to col. 4, line 14. Nagano teaches a shoe having a plate member for attaching a cleat and a removable cover member for covering a cleat-attaching area of the plate member. Nagano does not teach or suggest a torsion element, or even the desirability of a torsion element.

Applicant respectfully submits that the references cited fail to teach or suggest all the claim limitations insofar as Nagano fails to cure the deficiencies of Anderie with respect to amended independent claim 21. Claims 22 and 25 depend therefrom. Specifically, neither Anderie nor Nagano, alone or in combination, teach or suggest a torsion element with forefoot and rearfoot portions that span substantially a wearer's entire forefoot and rearfoot areas.

Reconsideration and withdrawal of the rejection of claims 22 and 25 based on Anderie in view of Nagano are respectfully requested.

5. Claims 2-4, 11-14, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over any of the references applied to claims 1 and 9 above.

For the reasons stated above, Applicant submits that claims 2-4, 11-14, and 18 are not obvious, because none of the references discussed above teach or suggest all of the claim limitations of independent claim 1, from which claims 2-4, 11-14, and 18 depend. Specifically, none of the references teach or suggest a torsion element with a forefoot portion spanning substantially an entire forefoot area of the sole.

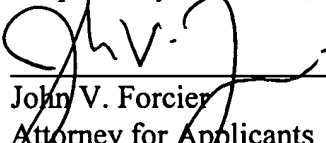
Reconsideration and withdrawal of the rejection of claims 2-4, 11-14, and 18 based on any of the references applied to claims 1 and 9 above are respectfully requested.

### CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1-25 in due course. The Examiner is invited to contact Applicant's undersigned representative by telephone at the number listed below to discuss any outstanding issues.

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Respectfully submitted,

  
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